

REMARKS

By this Amendment, Applicants amend claims 1 and 8 to more appropriately define the present invention, cancel claims 4, 5, 11, and 12, without prejudice or disclaimer of the subject matter thereof, and add new claim 15. Claims 1, 8, and 15 are now pending in this application.

In the Final Office Action,¹ the Examiner rejected claims 1, 4, 5, 8, 11, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Martensson (European Patent Application No. EP 498,997) in view of Osamu (Japanese Patent Application No. 2000134316). Applicants respectfully traverse the rejection, and note that because claims 4, 5, 11, and 12 have been canceled, the rejection with respect to these claims is moot.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim 1 recites a communication terminal including, among other things, a “display mode setting means for setting either *a first display mode for displaying only the received message received by said message receiving means* or a second display mode for displaying only the user identification information stored in the phone book” (emphasis added). The applied prior art references do not disclose or suggest at least this element.

The Examiner alleges that Martensson discloses a “display mode setting means for selectively setting a first display mode for displaying only the received message received by said message receiving means” at col. 6, lines 11-32 and “a second display mode for displaying only the stored user identification information stored in phone book” at col. 7, lines 2-21. See Office Action, page 2. Applicants disagree.

In Martensson, if a Calling Line Identification (CLI) signal is present, the telephone numbers stored in the numeric fields of the telephone number store 100 are compared with a CLI number. See col. 6, lines 11-16. If none of the stored numbers match the CLI number, the telephone is rung and the CLI number is displayed on the display. See col. 6, lines 16-19. In addition, Martensson discloses when a record in the telephone number store 100 contains a number corresponding to the CLI, then the record is located and displayed on LCD 5. See col. 6, lines 42-46 and col. 7, lines 2-11. However, as recited in claim 1, Applicants’ claimed “received message” includes “the caller phone number and the caller name in the message included in an incoming call signal from the network.” Since Martensson displays the CLI number when a match is not found, the reference fails to disclose or suggest a “display mode setting means for

setting ... a first display mode for displaying only the received message received by said message receiving means,” as recited in claim 1.

Moreover, Osamu does not make up for the deficiencies of Martensson. Instead, Osamu discloses that “the name corresponding to the call originating telephone number detected at the time of call incoming is read out of the one-action abbreviated telephone number table 8a and the read name is displayed.” See Abstract. “When there is no name corresponding to the call originating telephone number in the one-action abbreviated telephone number table 8a, the call originating name reported from the exchange is displayed in the call originating source information display area 4a.” See Abstract. Since Osamu discloses displaying a stored name or the call originating name reported from the exchange, Osamu also does not disclose or suggest a “display mode setting means for setting ... a first display mode for displaying only the received message received by said message receiving means,” as recited in claim 1.

Since Martensson and Osamu, whether taken alone or combination, do not disclose or suggest all of the elements of claim 1, the Examiner should withdraw the rejection of the claim. Claim 8, while of a different scope, includes similar recitations as those discussed above with regard to claim 1. Accordingly, the Examiner should also withdraw the rejection of claim 8.

New claim 15 is also neither disclosed or suggested by the applied references, whether taken alone or in combination.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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